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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,179	03/27/2002	Nobuaki Yatsuka	0230-0174P	3270

2292 7590 06/16/2003

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EXAMINER

FONDA, KATHLEEN KAHLER

ART UNIT

PAPER NUMBER

1623

DATE MAILED: 06/16/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/089,179	YATSUKA ET AL.
	Examiner Kathleen Kahler Fonda, Ph.D.	Art Unit 1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 3-27-02, 6-5-02, and 6-27-02.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1 and 8-16 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1 and 8-16 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5 and 7</u> .	6) <input type="checkbox"/> Other: _____

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 8-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The scope of claim 1 is unclear because there is a period at the end of line 5, but some text follows the period. There should be one period at the end of the claim. All remaining claims depend from claim 1, and therefore are also indefinite.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 8-16 are rejected under 35 U.S.C. 102(b) as being anticipated by FALK et al. (A). The reference teaches administration of hyaluronic acid, which is a compound according

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to Formula (1) of claim 1, to a balding human male. See column 32, lines 55-61. This teaching is especially relevant to claims 1, 8, 11, 15, and 16. The Examiner notes that alopecia, as recited in claim 11, is hair loss. However, no claim requires that the mammal to whom the compound is administered be afflicted with any disease or condition. Thus the claims reciting other diseases or conditions are also anticipated.

Claims 1 and 8-16 are rejected under 35 U.S.C. 102(b) as being anticipated by SHISEIDO (N). Because the reference is in Japanese, the Examiner relies in part on Derwent abstract 1999-005107 as an indication of its contents. The reference teaches that topical administration of a hyaluronic acid derivative, which is a compound according to Formula (1) of claim 1, can prevent formation of rough skin. See the Derwent abstract. This teaching is especially relevant to claims 1 and 13-16. The Examiner notes that claim 14 specifically recites prevention of rough skin. However, no claim requires that the mammal to whom the compound is administered be afflicted with any disease or condition. Thus the claims reciting other diseases or conditions are also anticipated.

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Claims 1 and 8-16 are rejected under 35 U.S.C. 102(b) as being anticipated by KANEBO (O). Because the reference is in Japanese, the Examiner relies in part on Derwent abstract 1995-182867 as an indication of its contents. The reference teaches that administration of a hyaluronic acid derivative, which is a compound according to Formula (1) of claim 1, can prevent hair loss and dandruff. See the Derwent abstract. This teaching is especially relevant to claims 1, 8, 10, 11, and 13-16. The Examiner notes that claim 10 specifically recites prevention or treatment of dandruff, while claim 11 recites prevention or treatment of alopecia (hair loss). However, no claim requires that the mammal to whom the compound is administered be afflicted with any disease or condition. Thus the claims reciting other diseases or conditions are also anticipated.

Claims 1 and 8-16 are rejected under 35 U.S.C. 102(b) as being anticipated by SKANDIGEN (P). The reference teaches administration of a hyaluronic acid derivative, which is a compound according to Formula (1) of claim 1, for treatment of acne vulgaris. See page 5, lines 14-26. This teaching is especially relevant to claims 1, 8, 9, 15, and 16. The Examiner notes that claim 9 specifically recites prevention or treatment of acne vulgaris. However, no claim requires that the mammal to

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whom the compound is administered be afflicted with any disease or condition. Thus the claims reciting other diseases or conditions are also anticipated.

No claim is allowed.

Papers relating to this application may be submitted to Technology Center 1600 by facsimile transmission. The number of the fax machine for official papers in Technology Center 1600 is (703) 308-4556. Any document submitted by facsimile transmission will be considered an official communication unless the cover sheet clearly indicates that it is an informal communication.

INTERNET INFORMATION: Secure and confidential access to patent application status information is now available; see <http://www.uspto.gov/ebc/index.html> for more information. Also, <http://www.uspto.gov/web/offices/ac/comp/fin/clonedefault.htm> may be used to pay patent maintenance fees, pay non-filing application fees, and maintain USPTO deposit accounts.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kathleen Kahler Fonda, at telephone number (703) 308-1620. Examiner Fonda can generally be reached Monday through Friday from 7:30

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a.m. until 4:00 p.m. If the Examiner cannot be reached, questions may be addressed to Supervisory Patent Examiner James O. Wilson at (703) 308-4624. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-1235.

*K. Fonda*  
Kathleen Kahler Fonda, Ph.D., J.D.  
Primary Examiner  
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